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09/977,118	10/12/2001	Tohgo Murata	700-286	1739
7590 Anthony R. Barkume, Esq. Greenberg Traurig, LLP 200 Park Avenue New York, NY 10166		05/18/2007	EXAMINER UTAMA, ROBERT J	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/977,118	Applicant(s) MURATA ET AL.	
	Examiner Robert J. Utama	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This office action is a response to the amendment filed on: 12/15/2005. The current statuses of claims are as follow: claims 1-36 are still pending; no claim has been cancelled or withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 6-10 and 25-29 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6-10 and 25-29 contain a limitation of (p), (t), and etc. The examiner is unable to determine if the label constitute a limitation or an alternate forms of the label.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claim 1-2, 4-5 and 19 rejected under 35 U.S.C. 102(b) as being anticipated by Walker US 5,802,533.**

Claim 1: Walker '533 provide a teaching of method to instruct a student to learn the English language comprised of: configuring a software program with a plurality of English sentence part and entering each of said predefined english sentence part into a corresponding field of a computer user interface (se Walker '533 col. 9:55-10:23); where the computer program is

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adapted to display each input field for each sentence entered and concatenate the plurality of input fields to provide a resultant English sentence for display to a user (see Walker FIG. 2).

Claim 2: Walker '533 provides a teaching where the software program display is a spreadsheet program and wherein each input is a cell in a spreadsheet (see Walker FIG. 2).

Claim 4: Walker '533 provides a teaching where a sentence phrase, comprised of two or more sentence part is assembled by the program and displayed on a field for viewing by the student (see Walker '533 FIG. 2 and col. 5:36-45).

Claim 5 and 19: Walker '533 provides a teaching where for each input fields, calculating the number of occurrences of each different sentence part input and the student selecting an input field, and displaying the calculation result for the input field (see FIG. 2 # of Syllables).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claim 3 ejected under 35 U.S.C. 103(a) as being unpatentable over Walker US 5,802,533 and in view of Tanaka et al US 5,088,038**

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Claim 3: While Walker '533 provide a teaching where the English sentence parts is labeled with the proper label (see Walker '533 FIG. 2 and col. 5:37-45), Walker failed to provide a teaching where the sentence part are labeled as subject, predicate, object, condition and pre-subject. Instead Walker used the label of "verb", "article", "noun" and etc.

Tanaka provides a teaching where predefined English sentence part as "subject" and "object" (see Tanaka FIG. 5-10 and col. 5:45-59). Therefore, it would have been oblivious to one ordinary skilled in the art to label predefined English sentence part as "subject" and "object", as taught by Tanaka, into the system of Walker because doing so will further explain the grammatical function of the sentence part to the student. However, Tanaka does not provide further teaching of labeling the sentence part as condition and/or pre-subject. However, it is the examiner position that further labeling effort such as claimed by the applicant using the label "condition" and "pre-subject" are a matter of design choice to further classify the sentence part.

9. Claim 6-10 ejected under 35 U.S.C. 103(a) as being unpatentable over Walker US 5,802,533 and in view of Tanaka et al US 5,088,038 and further in view of Kucera 4,864,502

Claim 6-10: Walker and Tanaka failed to provide a teaching where the subject being comprised of: people, things, abstract word, pronoun or interrogative (claim 6); the predicate being comprised of: verb as existence of an object, verb for action, people, things, abstract word, pronoun (claim 7); the object being comprised of: people, things, abstract word, pronoun and object complements (claim 8); the conditions being comprised of place, time, reason, method, if, preposition (claim 9) and the pre-subject being comprised of: there is, interjection, adverb word, conjunction, relative pronoun, interrogative word (claim 10). The combination of Walker and Tanaka failed to mitigate these deficiencies.

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Kucera provides a teaching where the tag comprises of: people (singular common noun and etc), things (noun), verb as existence of an object (verb third person singular and etc), people (singular possessive pronoun), pronoun (singular possessive pronoun), place, time, reason, method (WH- Determiner) [see Kucera FIG. 2-3]. Therefore, it would have been obvious to one ordinary skilled in the art to label predefined English sentence part as people, things, as taught by Kucera, into the system of Walker and Tanaka because doing so will further explain the grammatical function of the sentence part to the student. While there are certain components that are missing from the Kucera, Walter and Tanaka, it is the examiner's position that the difference as claimed by the applicant using the label "interrogative", "abstract word" and etc are a matter of design choice to further classify the sentence part.

10. Claim 11-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Walker US 5,802,533 and in view of Steele et al US 5,169,342

Claim 11-14: Walker fail to provide a teaching on having a visual aid in a field associate with each sentence entered (claim 11), where the visual aids is a static image (claim 12), the visual aid comprise of animated image file (claim 13) and wherein the students view the visual aid as part of learning the associated sentence (claim 14).

Steele provides a teaching of having a visual aid in a field associate with each sentence entered, where the image is a static image (see Steele col 3:60-4:17), the visual aid comprise of animated image file and wherein the students view the visual aid as part of learning the associated sentence (see Steele col. 6:35-65). Therefore, it would have been obvious for one of ordinary skilled in the art to include the feature of having a visual aid in a field associate with each sentence entered, where the visual aids is a static image, the visual aid comprise of animated image file and wherein the students view the visual aid as part of learning the associated sentence because it would expedites the learning of spoken and written language (see Steele col.1:15-23 and col. 2:37-43).

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Claim 15-16: Walker failed to provide teaching where the software is configured with a stored audio aid file in a field associated with each sentence entered, the audio file having substantive content related to the subject matter associated sentence and wherein the audio aid file is played via an audio output device associated with the housing when selected by the input mean (claim 15) and where the student listens to the audio aid as part of learning the associated sentence (claim 16).

Steele provides a teaching of software is configured with a stored audio aid file in a field associated with each sentence entered, the audio file having substantive content related to the subject matter associated sentence and wherein the audio aid file is played via an audio output device associated with the housing when selected by the input mean (see Steele col. 8:45-57). Therefore it would have been obvious for one of ordinary skilled in the art to include the feature of having stored audio aid file in a field associated with each sentence entered, as taught by Steele, into the combination of Fishkin and Walker because it would expedites the learning of spoken and written language (see Steele col.1:15-23 and col. 2:37-43).

11. Claim 11 and 17 rejected 35 U.S.C. 103(a) as being unpatentable over Walker US 5,802,533 and in view of Guinan US 6,022,222

Claim 17: Walker fail to provide a teaching on having a visual aid in a field associate with each sentence entered (claim 11) and where the software program is configured to further comment file in a field associated with each sentence entered, the comment file having substantive textual content related to the subject matter of the associated sentence (claim 17).

Guinan provides a teaching of having a visual aid in a field associate with each sentence entered (see Guinan col. 4:62-5:15) and where the software program is configured to further comment file in a field associated with each sentence entered, the comment file having substantive textual content related to the subject matter of the associated sentence (see Guinan FIG. 16 and col. 7:5-15). Therefore it would have been obvious for one ordinary skilled

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in the art to include the feature of on having a visual aid in a field associate with each sentence entered (claim 11) and where the software program is configured to further comment file in a field associated with each sentence entered, the comment file having substantive textual content related to the subject matter of the associated sentence, as taught by Guinan, into the system of Walker because it would further expedites the learning of spoken and written language (see Guinan col. 2:451-52).

12. Claim 18 rejected 35 U.S.C. 103(a) as being unpatentable over Walker US 5,802,533 and in view of Garman 5,926,822

Claim 18: Walker fails to provide a teaching of providing the student with a filter utility, the filter utility is adapted to extract the selected by the student, the filter criteria species a selection taken from at least one of the input fields.

Garman provides a teaching of an Excel spreadsheet which can be adapted to provide a student with a filter utility, the filter utility is adapted to extract the selected by the student, the filter criteria species a selection taken from at least one of the input fields (see Garman col.5:12-27). Therefore, it would have been obvious for one of ordinary skilled in art to provide a student with a filter utility, the filter utility is adapted to extract the selected by the student, the filter criteria species a selection taken from at least one of the input fields, as taught by Garman, into the system of Walker because it would enable the student to selectively select the sentence part of interest.

13. Claim 20-21, 23-24 and 36 rejected 35 U.S.C. 103(a) as being unpatentable over Walker US 5,802,533 and in view of Fishkin et al US 6,243,074

Claim 20: Walker '533 provide a teaching of method to instruct a student to learn the English language comprised of: configuring a software program with a plurality of English sentence part and entering each of said predefined english sentence part into a corresponding field of a

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computer user interface (see Walker '533 col. 9:55-10:23); where the computer program is adapted to display each input field for each sentence entered and concatenate the plurality of input fields to provide a resultant English sentence for display to a user (see Walker FIG. 2).

While Walker '533 provide a teaching of a device it fails to provide a device comprised of: a housing for being held in the hand of a student, a display screen attached to the housing and computer processing mean integrated within the housing.

Fishkin provides a teaching of a computing device with a housing for being held in the hand of a student (see Fishkin FIG. 4), a display screen attached to the housing and computer-processing mean integrated within the housing (see Fishkin FIG. 1, col. 3:24-26 and col. 5:1-9). Therefore it would have been obvious to include the feature of housing for being held in the hand of a student; a display screen attached to the housing and computer processing mean integrated within the housing, as taught by Fishkin, to the system of Walker because it would enable the system to be used as a portable system and the user can use the system anywhere (see Fishkin col. 1:14-20).

Claim 21: Walker '533 provides a teaching where the software program display is a spreadsheet program and wherein each input is a cell in a spreadsheet (see Walker FIG. 2).

Claim 23: Walker '533 provides a teaching where a sentence phrase, comprised of two or more sentence part is assembled by the program and displayed on a field for viewing by the student (see Walker '533 FIG. 2 and col. 5:36-45).

Claim 24 and 36: Walker '533 provides a teaching where for each input fields, calculating the number of occurrences of each different sentence part input and the student selecting an input field, and displaying the calculation result for the input field (see FIG. 2 # of Syllables).

14. Claim 22 as being unpatentable over Walker US 5,802,533 and in view of Fishkin et al US 6,243,074 and further in view of Tanaka et al US 5,088,038.

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Claim 22: While Walker '533 provide a teaching where the English sentence parts is labeled with the proper label (see Walker '533 FIG. 2 and col. 5:37-45), Walker failed to provide a teaching where the sentence part are labeled as subject, predicate, object, condition and pre-subject. Instead Walker used the label of "verb", "article", "noun" and etc. The combination of Walker and Fishkin failed to mitigate this deficiency.

However, Tanaka provides a teaching where predefined English sentence part as "subject" and "object" (see Tanaka FIG. 5-10 and col. 5:45-59). Therefore, it would have been oblivious to one ordinary skilled in the art to label predefined English sentence part as "subject" and "object", as taught by Tanaka, into the system of Walker because doing so will further explain the grammatical function of the sentence part to the student. However, Tanaka does not provide further teaching of labeling the sentence part as condition and/or pre-subject. However, it is the examiner position that further labeling effort such as claimed by the applicant using the label "condition" and "pre-subject" are a matter of design choice to further classify the sentence part.

15. Claim 25-29 as being unpatentable over Walker US 5,802,533 and in view of Fishkin et al US 6,243,074 and further in view of Tanaka et al US 5,088,038.

Claim 25-29: Walker and Tanaka failed to provide a teaching where the subject being comprised of: people, things, abstract word, pronoun or interrogative (claim 25); the predicate being comprised of: verb as existence of an object, verb for action, people, things, abstract word, pronoun (claim 26); the object being comprised of: people, things, abstract word, pronoun and object complements (claim 27); the conditions being comprised of place, time, reason, method, if, preposition (claim 28) and the pre-subject being comprised of: there is, interjection, adverb word, conjunction, relative pronoun, interrogative word (claim 29). The combination of Walker and Tanaka failed to mitigate these deficiencies.

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Kucera provides a teaching where the tag comprises of: people (singular common noun and etc), things (noun), verb as existence of an object (verb third person singular and etc), people (singular possessive pronoun), pronoun (singular possessive pronoun), place, time, reason, method (WH- Determiner) [see Kucera FIG. 2-3]. Therefore, it would have been obvious to one ordinary skilled in the art to label predefined English sentence part as people, things, as taught by Kucera, into the system of Walker and Tanaka because doing so will further explain the grammatical function of the sentence part to the student. While there are certain components that are missing from the Kucera, Walter and Tanaka, it is the examiner's position that the difference as claimed by the applicant using the label "interrogative", "abstract word" and etc are a matter of design choice to further classify the sentence part.

16. Claim 30-33 as being unpatentable over Walker US 5,802,533 and in view of Fishkin et al US 6,243,074 and further in view of Steele et al US 5,169,342

Claim 30-32: Walker fail to provide a teaching on having a visual aid in a field associate with each sentence entered (claim 30), where the visual aids is a static image (claim 31), the visual aid comprise of animated image file (claim 32).

Steele provides a teaching of having a visual aid in a field associate with each sentence entered, where the image is a static image (see Steele col 3:60-4:17), the visual aid comprise of animated image file and wherein the students view the visual aid as part of learning the associated sentence (see Steele col. 6:35-65). Therefore, it would have been obvious for one of ordinary skilled in the art to include the feature of having a visual aid in a field associate with each sentence entered, where the visual aids is a static image, the visual aid comprise of animated image file and wherein the students view the visual aid as part of learning the associated sentence because it would expedites the learning of spoken and written language (see Steele col.1:15-23 and col. 2:37-43).

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Claim 33: Walker failed to provide teaching where the software is configured with a stored audio aid file in a field associated with each sentence entered, the audio file having substantive content related to the subject matter associated sentence and wherein the audio aid file is played via an audio output device associated with the housing when selected by the input mean. The combination of Walker and Fishkin failed to mitigate this deficiency.

Steele provides a teaching of software is configured with a stored audio aid file in a field associated with each sentence entered, the audio file having substantive content related to the subject matter associated sentence and wherein the audio aid file is played via an audio output device associated with the housing when selected by the input mean (see Steele col. 8:45-57). Therefore it would have been obvious for one of ordinary skilled in the art to include the feature of having stored audio aid file in a field associated with each sentence entered, as taught by Steele, into the combination of Fishkin and Walker because it would expedite the learning of spoken and written language (see Steele col.1:15-23 and col. 2:37-43).

17. Claim 34 as being unpatentable over Walker US 5,802,533 and in view of Fishkin et al US 6,243,074 and further in view of Garman 5,926,822

Claim 34: Walker where the software program is configured to further comment file in a field associated with each sentence entered, the comment file having substantive textual content related to the subject matter of the associated sentence (claim 34).

Guinan provides a teaching where the software program is configured to further comment file in a field associated with each sentence entered, the comment file having substantive textual content related to the subject matter of the associated sentence (see Guinan FIG. 16 and col. 7:5-15). Therefore it would have been obvious for one ordinary skilled in the art to include the feature of on having a visual aid in a field associate with each sentence entered (claim 11) and where the software program is configured to further comment file in a field associated with each sentence entered, the comment file having substantive textual content related to the

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subject matter of the associated sentence, as taught by Guinan, into the system of Walker because it would further expedite the learning of spoken and written language (see Guinan col. 2:451-52).

18. Claim 35 as being unpatentable over Walker US 5,802,533 and in view of Fishkin et al US 6,243,074 and further in view of Garman 5,926,822.

Claim 35: Walker fails to provide a teaching of providing the student with a filter utility, the filter utility is adapted to extract the selected by the student, the filter criteria species a selection taken from at least one of the input fields.

Garman provides a teaching of an Excel spreadsheet which can be adapted to provide a student with a filter utility, the filter utility is adapted to extract the selected by the student, the filter criteria species a selection taken from at least one of the input fields (see Garman col.5:12-27). Therefore, it would have been obvious for one of ordinary skill in the art to provide a student with a filter utility, the filter utility is adapted to extract the selected by the student, the filter criteria species a selection taken from at least one of the input fields, as taught by Garman, into the system of Walker and Fishkin because it would enable the student to selectively select the sentence part of interest.

Response to Arguments

19. The drawing amendment filed on 12/15/2005 has been accepted by the examiner and is sufficient to remove the drawing rejection.

20. Applicant's argument and amendment is sufficient to remove the rejection under 35 U.S.C 112, second paragraph.

21. Applicant's arguments with respect to claim 1-36 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Utama whose telephone number is (571) 272-1676. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezutto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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